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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,204	11/22/2000	Sam B. Morrison	05725.0642-00	9514

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FINNEGAN, HENDERSON, FARABOW, GARRETT &
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1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/02/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,204

Applicant(s)

MORRISON, SAM B.

Examiner

Michael A. Willis

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Applicant's response of 17 April 2002 is entered. Claims 1-2 and 4-28 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

Applicant's election with traverse of styrene/butylene/ethylene/styrene as the species of at least one block copolymer film former in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the examiner has not shown a serious burden to the examination of all of the species. This is not found persuasive because the number of possible block copolymers is very large such that the large number of possibilities constitutes a burden for the search.

The requirement is still deemed proper and is therefore made FINAL. Claims 1-2 and 4-28 are examined as they read on the elected species.

Response to Amendment

The rejection of claims 2, 3, 5, 13, 14, and 25 under 35 USC 112, second paragraph, is withdrawn.

R sponse to Arguments

Claims 1-2, 6, 9-10, 12-13, 15-16, 22-23, and 27-28 are rejected under 35 USC 102(e) as being clearly anticipated by Knitowski et al (US Pat. 6,248,339) for reasons as stated previously. Applicant argues that Knitowski does not comprise a tri-block copolymer film former. However, Knitowski clearly discloses butylene-ethylene-styrene copolymer, which is the same as the elected species. Therefore, Knitowski meets the claimed limitation.

The following new rejections are made:

Claim Objections

Claim 2 is objected to because of the following informalities: the claim contains multiple periods. Each claim should begin with a capital letter and end with a period. Periods may not be used elsewhere in the claims except for abbreviations. See MPEP 608.01(m). Appropriate correction is required.

Claim Rejections - 35 USC § 102

Claims 1, 6-10, 16, 22-24, and 27-28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by DesLauriers et al (US Pat. 5,221,534). DesLauriers discloses health and beauty aid compositions comprising a gel made from mineral oil and blends of di- and triblock copolymers. DesLauriers describes KRATON series of copolymers, including styrene-ethylene-butylene-styrene (SEBS type) polymers (see col. 4, line 52 through col. 5, line 12). The copolymers are used in cosmetics (see col. 6,

lines 3-23). KRATON triblock polymers G1652 (SEBS type) are preferred components (see col. 9, lines 66-67; and Table 3). The resulting gels are mixed with dimethicone and cyclomethicone (see Tables 11 and 17). The gels are used in cosmetics such as mascara and blush, which contain powders (see col. 7, lines 4-53).

Claim Rejections - 35 USC § 103

Claims 1-2 and 4-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over DesLauriers (US Pat. 5,221,534) in view of Anton (US Pat. 6,066,313), Konik (US Pat. 6,060,072) or Kimura (US Pat. 4,528,390).

DesLauriers teaches health and beauty aid compositions comprising a gel made from mineral oil and blends of di- and triblock copolymers. The gels provide an excellent media or vehicle for delivery of beauty aids such as mineral oils to the skin (see col. 3, lines 7-23). DesLauriers describes KRATON series of copolymers, including styrene-ethylene-butylene-styrene (SEBS type) polymers (see col. 4, line 52 through col. 5, line 12). The copolymers are used in cosmetics (see col. 6, lines 3-23). KRATON triblock polymers G1652 (SEBS type) are preferred components (see col. 9, lines 66-67; and Table 3). The resulting gels are mixed with dimethicone and cyclomethicone (see Tables 11 and 17). The gels are used in cosmetics such as mascara and blush, which contain powders (see col. 7, lines 4-53). DesLauriers generically teaches the use of silicones (see col. 6, lines 38-410, but the reference lacks particular species of silicones.

Anton teaches the use of linear volatile silicones with 9 or fewer silicon atoms as volatile solvents in cosmetics. The oils include hexamethyldisiloxane (see col. 5, lines 1-

13). The volatile oils enable easy formulation and leave the non-volatile ingredients on the skin (see col. 4, lines 35-53).

Konik teaches the use of film-forming agents in transfer resistant cosmetic compositions. Konik teaches that the film-forming agent provides waterproofing properties, improve the wear of the composition, and confer transfer-resistance to the makeup product (see col. 2, lines 17-34). Trimethylsiloxysilicate and polyethylene polymers are taught as a useful film-forming agent.

Kimura teaches the preparation of polymethylsilsesquioxanes. The title compounds are taught as useful anti-caking agents for powder products and as additives for cosmetics (see col. 3, lines 1-31).

The missing ingredients are all known components of cosmetic compositions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of DesLauriers by the incorporation of linear volatile silicones for the ease of formulation imparted by the silicones as taught by Anton, by the addition of trimethylsiloxysilicate and polyethylene polymers for the improved properties of the film-forming agents as taught by Konik, or by the incorporation of polymethylsilsesquioxanes for their anti-caking properties in cosmetics as taught by Kimura.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 and 4-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-7, 16, and 24 of copending Application No. 09/258,809. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation of emulsion foundation clearly encompasses organosilicone emulsifiers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alternate Mon. and Tues. to Fri. from 9am-6:30pm.

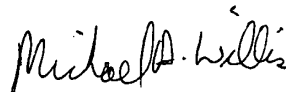
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

July 1, 2002



MICHAEL G. HARTLEY
PRIMARY EXAMINER